Attorney Docket No. 00533

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

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04/02/03

In re application of:	:	
Keith E. Newman, et al.	:	METHOD OF PRODUCING POWDER METAL PARTS FROM METALLURGICAL POWDERS INCLUDING SPONGE IRON
Serial No.: 09/887,289	:	
Filed: June 22, 2001	:	
Art Unit: 1742	:	Group 1700

RESPONSE TO OFFICE ACTION

Pittsburgh, Pennsylvania 15222
March 25, 2003

Commissioner for Patents
Washington, DC 20231

Sir:

The above-identified patent application (the "Subject Application") currently includes claims 1-43. In the September 25, 2003 Office Action (the "Office Action) issued in the Subject Application the Examiner rejects each of claims 1-43 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,375,709 B1 to Storstrom et al. ("Strostrom"), in view of U.S. Patent No. 4,720,615 to Dunn ("Dunn"). The Examiner asserts that Strostrom teaches a method of forming a sintered metal compact comprising: providing a metal powder from a group of materials including atomized iron powder and sponge iron; providing additions to the metal powder selected from

lubricants, graphite, alloying elements, binders and plasticizers; pressing the metal powder to form a compacts; and sintering the compact to form a sintered metal compact. The Examiner states that Storstrom does not teach any specific compacting pressures or sintering techniques. The Examiner states that Dunn teaches the use of inductive sintering of metal powder compacts to produce sintered bodies of high uniformity. The Examiner concludes that it would have been obvious to one having ordinary skill to use inductive sintering as taught by Dunn in the Strostrom invention to produce sintered metal compacts of high uniformity. The Examiner further concludes that one of ordinary skill would select compacting pressure "by routine experimentation based on the selection of specific starting materials to produce a sintered body of high density, the selection thus being obvious to one of ordinary skill in the art.

To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the cited prior art. *See, e.g.,* MPEP §2143.03. Also, while a prima facie finding of obviousness necessarily includes the combining of prior art teachings, various prior art teachings are not properly combined unless there is something in the prior art itself that suggests that those teachings could or should be combined. MPEP §2143.01. Put another way, the mere fact that prior art teachings can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination or modification. MPEP §2143.01. In addition, it must be remembered that a prior art reference must be considered in its entirety, *i.e.*, as a whole, including portions that would lead away from the claimed invention. MPEP §2141.02.